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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/918,756	07/30/2001	Clayton Neil Cowgill	7916-9	2745
20306	7590	05/21/2004		
MCDONNELL BOEHNEN HULBERT & BERGHOFF LLP 300 S. WACKER DRIVE 32ND FLOOR CHICAGO, IL 60606				
			EXAMINER CHAU, COREY P	
			ART UNIT 2644	PAPER NUMBER 5

DATE MAILED: 05/21/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/918,756

Applicant(s)

COWGILL, CLAYTON NEIL

Examiner

Corey P Chau

Art Unit

2644

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 July 2001.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 30 July 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claims 4, 10, and 15 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The specification discloses that the expansion module is replaceable which involves opening the remote case, removing the original module and replacing it with a new module, however when a module is replaced, it is essentially removable. The expansion module as discloses in Fig. 2 is not removable.

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 4, 10, and 15 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In regards to Claims 4, 10, and 15, the specification discloses the expansion module in Fig. 2 is not a removable expansion module which contradicts what is claimed in Claims 4, 10 and 15. Therefore the specification does not clearly disclose a removable expansion module.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

6. Claims 1, 6, 12, 16 and 19 are rejected under 35 U.S.C. 102(a) as being anticipated by U.S. Patent Application Publication No. 2001/004397 to Kita et al. (hereafter as Kita).

7. Regarding Claim 1, Kita discloses a portable audio device (i.e. music reproducing device), comprising a digital audio player operable to convert digital signals stored in a memory to audio signals (i.e. music reproducing means for reproducing the music data stored in the first storage means); audio outputs (603) operable to allow a user to hear the audio signals; and an expansion module operable to provide additional capacity to the digital audio player, wherein the expansion module resides at a location away from the digital audio player (i.e. an external device comprising second storage means for storing music data; and sending means for sending the music reproducing device the music data stored in the second storage means) (pages 1-2, paragraphs 0019 to 0024)

8. All elements of Claim 6 are comprehended by Claim 1 and is rejected for the reason stated above apropos to Claim 1.

9. Claim 12 is essentially similar to Claim 6 and is rejected for the reasons stated above apropos to Claim 6.

10. Claim 16 is essentially similar to Claim 6 and is rejected for the reasons stated above apropos to Claim 6.

11. Claim 19 is essentially similar to Claim 6 and is rejected for the reasons stated above apropos to Claim 6.

Claim Rejections - 35 USC § 103

12. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

13. Claims 1, 2, 3, 5, 7, 8, 9, 11, 13, 14, 17, 18, and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fig. 4 in U.S. Patent No. 5504658 to Matsuda et al. (hereafter as Fig. 4) in view of U.S. Patent No. 6342664 to Sawada et al. (hereafter as Sawada).

14. Regarding Claim 1, Fig 4 discloses remote control unit for a portable audio unit comprising the portable audio unit (10); an audio outputs operable to allow a user to hear the audio signals (15); and an expansion module (19) operable to provide additional capacity to the digital audio player (19), wherein the expansion module resides at a location away from the digital audio player (Fig. 4). Fig. 4 discloses a portable audio unit, but only generally; no specific hardware or software is taught. Therefore it would have been obvious to one having ordinary skill in the art to seek

known portable audio unit. Sawada discloses a reproducing device (i.e. portable audio unit) comprising a memory attachment portion to which a stick-like memory device including a built-in semiconductor memory can detachably be attached; a battery wherein the reproducing device is operated by electrical power from the battery; and an audio unit for executing reproduction processing of audio data (i.e. operable to convert digital signals stored in memory to audio signals). It would have been obvious to one having ordinary skill in the art at the time the invention was made to utilize any known portable audio unit, such as that of Sawada. Therefore, it would have been obvious to modify the unit of Fig. 4 with the teaching of Sawada to utilize the reproducing device to produce music.

15. Regarding Claim 2, Fig. 4 as modified discloses the portable audio unit comprising a remote control (11) connected to the player and the audio outputs (Fig. 4).

16. Regarding Claim 3, Fig. 4 as modified discloses the portable audio unit wherein the expansion module (19) resides on the remote control (Fig. 4) (column 1, lines 19-23).

17. Regarding Claim 5, Fig. 4 as modified discloses audio outputs, outputted from the portable audio unit (10), which travel along the path of the remote control (11), therefore the expansion module resides in the audio outputs.

18. Regarding Claim 7, Fig. 4 discloses the portable audio unit, wherein the expansion module contains a battery (19).

19. Claim 8 is essentially similar to Claim 1 and is rejected for the reasons stated above apropos to Claim 1.

20. Claim 9 is essentially similar to Claim 3 and is rejected for the reasons stated above apropos to Claim 3.
21. Claim 11 is essentially similar to Claim 5 and is rejected for the reasons stated above apropos to Claim 5.
22. Claim 13 is essentially similar to Claim 7 and is rejected for the reasons stated above apropos to Claim 7.
23. Claim 14 is essentially similar to Claim 1 and is rejected for the reasons stated above apropos to Claim 1.
24. Claim 17 is essentially similar to Claim 7 and is rejected for the reasons stated above apropos to Claim 7.
25. Claim 18 is essentially similar to Claim 1 and is rejected for the reasons stated above apropos to Claim 1.
26. Claim 20 is essentially similar to Claim 7 and is rejected for the reasons stated above apropos to Claim 7.

Conclusion

27. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Corey P Chau whose telephone number is (703)305-0683. The examiner can normally be reached on Monday - Friday 9:00 am - 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Forester W Isen can be reached on (703)305-4386. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

May 17, 2004


FORESTER W. ISEN
SUPERVISORY PATENT EXAMINER